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10/722,238	11/24/2003	Terrance A. Tomkow	RPOST-66230	6674

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FULWIDER PATTON LLP
HOWARD HUGHES CENTER
6060 CENTER DRIVE, TENTH FLOOR
LOS ANGELES, CA 90045

EXAMINER	
TAYLOR, NICHOLAS R	
ART UNIT	**PAPER NUMBER**
2141	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/722,238	TOMKOW, TERRANCE A.	
	Examiner	Art Unit	
	NICHOLAS TAYLOR	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 December 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-18 have been presented for examination and are rejected.

2. The proposed amendments to the specification filed on December 18th, 2007, are approved.

Response to Arguments

3. Applicant's arguments filed January 18th, 2008, have been fully considered but they are deemed not persuasive.

4. In the remarks, applicant argued in substance that:

(A) The prior art of Barkan does not teach transmitting a message from a server to a recipient, the message including a pixel for indicating opening of the message at the recipient at the server. Barkan requires that a recipient accept or reject a message and is therefore unlike the claimed method that requires a transmitted message containing a pixel that is altered.

As to point (A), Barkan teaches a method for email transmission that includes both registered and secure methods of transmittal (abstract). These methods include a plurality of intermediaries or “post offices” that are used in sending secure messages

over the network (abstract and fig. 1). One of the secure methods taught by brings a receipt to a first user indicating the message was opened by the recipient (abstract).

Barkan teaches a method where a recipient receives a transmitted message that includes a pixel for indicating the opening of the message at the recipient at the server, providing an encrypted hash of the message at the server, and transmitting the indication to the recipient (see algorithm of pgs. 29-34). As to the argument that certain features of Barkan teach away from Applicant's claimed invention (e.g., use of acceptance/rejection procedure and lack of a need for keys), these features are not recited in the claim language and therefore do not limit the applicability of Barkan's disclosure.

(B) The prior art of Ouchi requires that intermediary stations be known to the sender before the message is sent. Applicant's method does not require the use of a route manager or a SQL database of addresses. Rather, Applicant's method receives an attachment that contains a list of the interim stations that a message has passed through on a network on its way to and from an intended recipient of a message. The identity of those interim stations is not known to the sender before the message is sent, but rather are a result of the network routing of the message.

As to point (B), Ouchi teaches an email communication and notification system that provides an attachment that lists the interim stations which receive a message during the transmission of the message from the server to the recipient and back to the

server (Ouchi, see fig. 9, col. 12, lines 11-15, and col. 5, lines 16-42). As to the argument that Ouchi uses a route manager or SQL database to manage the addresses, which would be unnecessary in Applicant's claimed embodiment, no such limitations are present in the independent claims that would preclude the use of additional route management tools in determining the composition of the list of interim stations. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Terminal Disclaimer

5. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c). As a result, the terminal disclaimer filed on December 18th, 2007, is not approved.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-18 are provisionally rejected on the ground of nonstatutory double patenting over claims 115-121 of copending Application No. 09/626577, as filed 5/18/2007. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that

copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: independent claim 115's scope includes the limitations present in claims 1-18, including a displaced server receiving a message from a sender, sending the message to a destination recipient, receiving the original message along with verification of the message (via an "indication" in the present application), and transmitting the verification to the sender.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Barkan, (International Pub. No. WO 98/17042).

10. As per claim 1, Barkan teaches a method of transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of:

receiving the message at the server from the sender, transmitting the message from the server to the recipient, (Barkan, pages 29 and mail server 31 of fig. 1)

the message including a pixel for indicating the opening of the message at the recipient at the server, (Barkan, pages 30-31)

providing an encrypted hash of the message, including the indication of the opening of the message at the recipient, at the server, and transmitting the message, including the indication of the opening of the message at the recipient, and the encrypted hash to the sender (Barkan, pages 33-34).

11. As per claim 2, Barkan teaches the system further including the steps at the server of:

receiving at the server the message, including the indication of the opening of the message at the recipient and the encrypted hash of the message, and determining the authenticity of the message, including the opening of the message at the recipient, on the basis of the hash of the message, including the indication of the opening of the message at the recipient, and the hash decrypted from the encrypted hash (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

12. As per claim 3, Barkan teaches the system further including the steps at the server of: receiving from the sender the message, including the indication of the opening of the message at the recipient, and the encrypted hash of the message, including the indication of the opening of the message at the recipient, hashing the message, including the indication of the opening of the message at the recipient, to provide a first digital fingerprint of the message including the indication of the opening of the message at the recipient, (Barkan, page 23)

decrypting the encrypted hash of the message, including the indication of the message at the recipient, to provide a second digital fingerprint of the message including the indication of the opening of the message at the recipient, and comparing the first and second digital fingerprints to determine the authenticity of the message including the indication of the opening of the message at the recipient (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

13. As per claim 4, Barkan teaches the system further including the steps at the server of:

indicating to the sender the results of the comparison, and (Barkan, page 33)

disposing of the message, and including the indication of the opening of the message at the recipient, and the encrypted hash of the message, including the indication of the opening of the message at the recipient, when the message and the encrypted hash are transmitted by the server to the sender (Barkan, page 35).

14. As per claim 5, Barkan teaches the system further wherein the server receives the message from the sender through the internet, the server transmits the message to the recipient through the internet, the server receives the message, including the indication of the opening of the message at the recipient, through the internet, and the server transmits the message, including the indication of the opening of the message at the recipient, through the internet to the sender (Barkan, see page 13).

15. As per claim 6, Barkan teaches the system further wherein the server indicates the results of the compression to the sender through the internet and wherein the server disposes of the message, including the indication of the opening of the message at the recipient, and the encrypted hash of the message, including the indication of the opening of the message, when the message and the encrypted hash are transmitted by the server to the sender through the internet (Barkan, see page 13).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claims 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan, (International Pub. No. WO 98/17042) and Ouchi (U.S. Patent No. 5,978,836).

18. As per claims 7 and 13, Barkan teaches a method of transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of:

receiving the message at the server from the sender, transmitting the message from the server to the recipient, (Barkan, pages 29 and mail server 31 of fig. 1)

the message including a pixel for indicating the opening of the message at the recipient, (Barkan, pages 30-31)

receiving the message, including the indication of the opening of the message the recipient, at the server, (Barkan, pages 32-33, where the user replies with an opened indication including the message)

providing encrypted hashes of the message, including the indication of the opening of the message at the recipient, and the attachment, and transmitting to the sender the message, including the indication of the opening of the message the recipient, and the attachment, and the encrypted hashes of the message, including the opening of the message at the recipient, and the attachment (Barkan, pages 33-34).

Barkan fails to teach receiving an attachment at the server including an indication of the interim network stations which receive the message during the transmission of the message from the server to the recipient and back to the server.

Ouchi teaches an email communication and notification system that provides an attachment that lists the interim stations which receive a message during the transmission of the message from the server to the recipient and back to the server (Ouchi, see fig. 9, col. 12, lines 11-15, and col. 5, lines 16-42).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Barkan and Ouchi to provide the email method of Ouchi in the system of Barkan, because doing so would provide increased security and verification by providing the sender with information on all systems that transmitted the message (Ouchi, col.2, lines 1-12).

19. As per claim 8, Barkan-Ouchi teaches the system further including the steps at the server of:

receiving at the server the message, including the indication of the opening of the message at the recipient, the attachment and the encrypted hashes of the message, including the indication of the opening of the message at the recipient, and the attachment, and determining the authenticity of the message, including the opening of the message at the recipient, on the basis of the hash of the messages, including the indication of the opening of the message at the recipient, and the hash decrypted from the encrypted hash and the authenticity of the attachment on the basis of the hashed attachment and the hash decrypted from the encrypted hash of the attachment (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

20. As per claims 9 and 15, Barkan-Ouchi teaches the system further including the steps at the server of:

reviewing from the sender the message, including the indication of the opening of the message at the recipient, the encrypted hash of the message, including the indication of the opening of the message at the recipient, the attachment and the encrypted hash of the attachment, hashing the message, including the indication of the opening of the message the recipient, and the attachment to provide first digital

fingerprints of the message, including the indication of the opening of the message at the recipient and the attachments, (Barkan, page 23)

decrypting the encrypted hash of the message, including the indication of the opening of the message at the recipient, and the attachment to provide second digital fingerprints of the message, including the indication of the opening of the message at the recipient and the attachment, and comparing the first and second digital fingerprints of the message, including the indication of the opening of the message at the recipient, to determine the authenticity of the message, including the indication of the opening of the message at the recipient and first and second fingerprints of the attachment to determine the authenticity of the attachment (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

21. As per claims 10 and 16, Barkan-Ouchi teaches the system further including the steps at the server of:

indicating to the sender the results of the comparisons, and (Barkan, page 33)

disposing of the message, including the indication of the opening of the message at the recipient, and the encrypted hash of the message, including the indication of the opening of the message at the recipient, and the attachment and encrypted hash of the attachment when the message, the attachment and the encrypted hashes are transmitted by the server to the sender (Barkan, page 35).

22. As per claim 11, Barkan-Ouchi teaches the system further wherein the server receives the message from the sender through the internet and wherein the server transmits the message to the recipient through the internet and wherein the server re-transmits the message, including the indication of the opening of the message at the recipient, to the recipient through the internet and wherein the server transmits the message through the internet to the sender (Barkan, see page 13).

23. As per claim 12, Barkan-Ouchi teaches the system further wherein the server indicates the results of the comparison to the sender through the internet and wherein the server disposes of the message, the attachment and the encrypted hashes of the message and the attachment when the message and the encrypted hash are transmitted by the server to the sender through the internet (Barkan, see page 13).

24. As per claim 14, Barkan-Ouchi teaches the system further including the steps at the server of: receiving the message, the attachment and the encrypted hash of the combination of the message and the attachment from the sender, hashing the combination of the message and the attachment to provide a first digital fingerprint and decrypting the encrypted hash of the combination of the message and the attachment to form a second digital fingerprint, and determining the authenticity of the message and the attachment on the basis of the first and second digital fingerprints (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

25. As per claims 17, Barkan-Ouchi teaches the system further wherein the server receives the message from the sender through the internet, the server transmits the message to the recipient through the internet, the server receives the message, including the indication of the opening of the message the recipient, through the internet, and the server transmits the message, including the indication of the opening of the message at the recipient, through the internet to the sender (Barkan, see page 13).

26. As per claims 18, Barkan-Ouchi teaches the system further wherein the server indicates the results of the compression to the sender through the internet and wherein the server disposes of the message, including the indication of the opening of the message at the internet, and the encrypted hash of the message, including the indication of the opening of the message, when the message and the encrypted hash are transmitted by the server to the sender through the internet (Barkan, see page 13).

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/NT/
Nicholas Taylor
Examiner
Art Unit 2141

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145